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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,999	12/20/2005	Josef Wimmer	037068.53616US	1997

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EXAMINER

NGUYEN, XUAN LAN T

ART UNIT	PAPER NUMBER
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3683

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/534,999

Applicant(s)

WIMMER ET AL.

Examiner

Lan Nguyen

Art Unit

3683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-32 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 11-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 December 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3 IDS's</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.
2. Document DE 9422342 has been crossed out because the document is missing. Please resubmit the document to be considered.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the details of the grooves as described in the specification in paragraph [0037] and in claims 11 and 24. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be

canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The abstract of the disclosure is objected to because the abstract is too long and contains legalese. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 11-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claims 11 and 24 claim “an opposite thread” and “an opposing thread”, respectively, without a corresponding reference to distinguish which thread is being claimed.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 11, 18, 19, 21-24 and 30-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumgartner et al. (USP 5,568,845).

Re: claim 11, Baumgartner shows a disc brake for use with a brake disc, in figures 2A and 2B as in the present invention, comprising: an axially slideable caliper 2 which straddles the brake disc 1 when in use; a brake application device arranged in the caliper on one side of the brake disc, the brake application device comprising a transverse beam 7 having at least one threaded bore, not numbered, as shown in figure 2B, into which an adjusting screw 71 carrying a pressure piece 13 is threaded, the brake application device being configured to press a brake pad 10 against the brake disc when in use; wherein the brake application device further comprises an adjusting device operatively coupled with the adjusting screw, the adjusting device adjusting for a change in a release play between the brake pad and the brake disc, not illustrated but mentioned in column 5, lines 47-50; and further wherein the brake application device

comprises a spring ring 801 disposed in a ring groove formed in the adjusting screw, the spring ring being elastically supported on an opposite thread so as to provide a rotation-inhibiting effect on the adjusting screw up to a defined torque, as stated in the Abstract, lines 6-8. Please note the rejection of the claimed feature "an opposite thread" above.

Re: claims 18 and 19, Baumgartner shows the groove as claimed wherein the walls of elements 7 and 800 are not sloped and the width of the groove corresponds to the width of the spring, as shown.

Re: claims 21-23, Baumgartner shows the brake as claimed in claims 21-23.

Re: claim 24, Baumgartner shows a brake application device for use in a caliper 1 of a disc brake in figures 2A and 2B, as in the present invention, comprising: a transverse beam 7 having a first threaded bore, as shown; a threaded adjusting screw 71 which screws into the first threaded bore, as shown; a wear adjustment device operatively coupled with the adjusting screw for use in compensating wear of the disc brake, as mentioned in column 5, lines 47-50; a ring groove formed in the threaded adjusting screw, as shown; and a spring ring 801 disposed in the ring groove so as to be elastically supported on an opposing thread of the threaded adjusting screw, the spring ring providing a rotation-inhibiting effect on the threaded adjusting screw up to a defined torque, as stated in the Abstract lines 6-8.

Re: claims 30 and 31, Baumgartner shows the groove as claimed wherein the walls of elements 7 and 800 are not sloped and the width of the groove corresponds to the width of the spring, as shown.

Re: claim 32, Baumgartner shows the brake as claimed in claim 32.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al. (USP 5,568,845).

Re: claim 20, it is believed that the claimed features in claim 20 is engineering design choices as stated in claim 20; since claim 20 lacks any structural recitation of the spring and only recites the criteria for the spring in accordance with a damping force.

11. Claims 12-17 and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgartner et al. (USP 5,568,845) in view of Bachler et al. (USP 4,642,995).

Re: claims 12, 14-17, 25 and 27-29, Baumgartner's brake, as rejected above, is silent of the material of the spring 801. Bachler is relied upon for the teaching of various metal springs as shown in the figures wherein the springs 3, 4, etc. are formed of sheet metal cut into strip, column 3, lines 26 and 56. Spring 3 has an undulated contour. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified Baumgartner's brake to employ one of the various metal springs as taught by Bachler since it is well known in the art of springs that any of these springs taught by Bachler would be capable of performing the task of biasing.

Re: claims 13 and 26, the Examiner takes an Official Notice that steel is well known as a metal with superior resiliency and resistance to rust and would have been an obvious choice of a metal for use with the springs.

Double Patenting

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claim 11-13 and 24-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3, 20 and 21 of copending Application No. 11/282,589. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claims in the instant application is broader and would have encompasses the scope of the claims of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Farr (2 documents) and Harrison are cited for other brake systems with a locking mechanism.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lan Nguyen whose telephone number is (571) 272-7121. The examiner can normally be reached on Monday through Friday, 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James McClellan can be reached on (571) 272-6786. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Xuan Lan Nguyen/ 3-26-07
Primary Examiner
Art Unit 3683